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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,711	02/07/2001	Tomoji Asada	450100-02994	4182
20999	7590	01/04/2006	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			TRAN, THAI Q	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/778,711

Applicant(s)

ASADA ET AL.

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Dec. 12, 2005 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh et al (US 6,700,989 B1) in view of Liebenow (US 6,601,074 B1) and further in view of Kim et al (US 5,799,081).

Regarding claim 1, Itoh et al discloses a receiving system (Fig. 27) composed of a receiving device, a monitor device for displaying an output of said receiving device, and an external recording device to be controlled by said receiving device, said receiving device comprising:

external device control means (a readout/reception device 80 of Fig. 27, col. 31, lines 29-61) for setting an operation of said external recording device; and

control means (a readout/reception device 80 of Fig. 27, col. 31, line 29 to col. 32, line 59 and col. 34, lines 55-65) for, when a recording input is given, determining whether or not a program being received is copy protected, setting said external recording device to a recording state if said program is initially found not copy protected, and disabling control said external recording device if said program is found copy protected before recording said received program onto said external recording device; whereby said external recording device is prevented from recording received copy protected programs. However, Itoh et al does not specifically disclose on-screen display control means for displaying a screen corresponding to various setting states and arranging items on said screen and the newly added limitation "determining means

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for determining if said program is recordable based on Entitlement Control Message (ECM) data and Entitlement Management Message (EMM) data”.

Liebenow teaches that the program can be requested for recording using the electronic program guide (EPG) (Fig. 2, col. 3, lines 18-39 and from col. 4, line 66 to col. 5, line 57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of requesting a program to be recorded by using electronic program guide as taught by Liebenow into Itoh et al's system in order to simplify the process of requesting program to be recorded.

The proposed combination of Ito et al and Liebenow above does not specifically disclose the newly added limitation “determining means for determining if said program is recordable based on Entitlement Control Message (ECM) data and Entitlement Management Message (EMM) data”.

Kim et al teaches in col. 2, lines 35-40 and in col. 3, lines 25-33 that “Access card 22, whose size is similar to that of a general credit card, has a built-in IC. With this, the card receives CA-related information through a broadcast bit stream and telephone line, that is, a telco MODEM, in order to decide whether a user, subscriber, -selected channel can be viewed or not and to collect its subscription fee” and “More specifically, CA unit 37, included in smart card 22, is made up of smart card 38 for CA and microcomputer 39 operated with CA software. The CA function is performed when the following two kinds of data are transmitted from a broadcasting station to the IRD. In other words, there are two types of data such as entitlement control message (ECM) or

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control word packet (CWP), and entitlement management message (EMM) or conditional access packet (CAP)".

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the CA unit as taught by Kim et al into Itoh et al's system in order to decide whether a user, subscriber, -selected channel of the digital broadcasting media can be viewed or not and to collect its subscription fee.

Regarding claim 2, the proposed combination of Itoh et al, Liebenow, and Kim et al discloses all the claimed limitations as discussed above with respect to claim 1 except for providing the claimed wherein, if said program is found copy protected when said recording input is given, a warning indicative of copy protection is displayed on said screen.

The capability of displaying a warning indicative of copy protection on an on-screen display device is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known displaying a warning indicative of copy protection on an on-screen display device into Itoh et al's system in order to notify the user that the program can not be recorded so that the user can determine whether to record the program again.

Regarding claim 3, Itoh et al also discloses the claimed wherein, when said recording input is given, an on-screen display is provided for stopping recording (col. 31, lines 29-40 and col. 34, lines 55-65).

Regarding claim 4, Itoh et al discloses the claimed wherein, when said recording input is given, a button for stopping recording is put in a selected state on said screen (col. 31, lines 29-40 and col. 34, lines 55-65).

Regarding claim 5, Liebenow teaches the claimed wherein said external device control means controls said external recording device by using an AV mouse (the mouse disclosed in col. 3, lines 2-17).

Regarding claim 6, the proposed combination of Itoh et al, Liebenow, and Kim et al discloses all the claimed limitations as discussed above with respect to claim 1 except for providing the claimed wherein said external device control means controls said external recording device by using an IEEE 1394 interface.

Itoh et al also disclosed in col. 2, lines 45-55 the well known IEEE1394 interface.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known IEEE 1394 into the combination of Itoh et al and Liebenow in order to increase the transmitting speed of the data because IEEE 1394 has high transfer speed.

Claims 7-12 are rejected for the same reasons as discussed in claims 1-6 above.

Method claims 13-18 are rejected for the same reasons as discussed in apparatus claims 1-6 above.

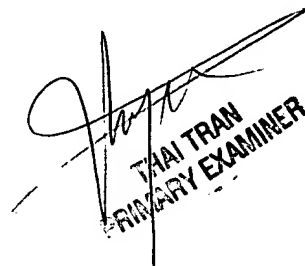
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (571) 272-7382. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ



THAI TRAN  
PRIMARY EXAMINER